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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,298	10/15/2001	Avi J. Ashkenazi	GNE.2630P1C2	4699

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HELLER EHRMAN WHITE & MCAULIFFE LLP  
275 MIDDLEFIELD ROAD  
MENLO PARK, CO 94025-3506

EXAMINER

TURNER, SHARON L

ART UNIT PAPER NUMBER

1647

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/978,298

**Applicant(s)**

ASHKENAZI ET AL.

**Examiner**

Sharon L. Turner

**Art Unit**

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 58-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-20-02, 4-23-02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS 9-13-02, 7-9-03  
attached AA902726 and AA 689524

## DETAILED ACTION

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e), 120 and 365(c) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant's have amended the first line of the specification as directed in the preliminary amendment submitted 9-3-02. Applicant's have also submitted a supplemental communication providing a priority map which identifies particular applications in which PRO181 (SEQ ID NO:322) is allegedly disclosed. The map notes the first disclosure within US provisional 60/081,955 within Figure 2. However, Figure 2 of the '955 provisional application fails to provide support for the noted sequence of SEQ ID NO:322. Support is found within the PCT/US99/05028 application filed 3-8-1999, Figure 129 for SEQ ID NO:322. As the subject matter is not apparently supported prior to the 3-8-1999 date, this date (3-8-1999) is the effective filing date awarded instant claims.

Should the Applicant disagree with the Examiner's factual determination above, it is incumbent upon the Applicant to provide the serial number and

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specific page and line numbers of any parent application filed prior to 3-8-1999 which specifically supports the claim limitations for each and every claim limitation in all the pending claims which Applicant considers to have been in possession of and fully enabled prior to 3-8-1999.

### **Information Disclosure Statement**

2. The Examiner notes corrections as to the public availability dates of Genbank Accession numbers AA902726 (9 April 1998) and AA689524 (19 Dec. 1997) cited within the PTO-1449. Copies of the Accessions, with the created public availability data noted, are attached herein for Applicant's reference.

### **Utility**

3. Utility is established based upon the chondrocyte redifferentiation assay noted for PRO 181, SEQ ID NO:322 at pp. 360-61 of the specification. The specification notes particular teachings with respect to PRO181, SEQ ID NO:322 at Figure 129, pp. 80, 169, 205, 274, 316, 322, 347-48, and 360-361.

### **Specification**

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### **Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 58-63 are rejected under 35 U.S.C. 102(e) as being anticipated by IDS reference Hillman et al., US Patent No. 5,968,744 issued Oct. 19, 1999.

Hillman et al., teach the human cornichon molecule (SEQ ID NO:1) which shares 100% sequence identity with instant PRO181, SEQ IDNO:322 identified as the peptide encoded by the cDNA deposited in ATCC209775. Hillman further teaches antibodies that bind or specifically bind to the sequence of SEQ ID NO:1, see in particular column 2, lines 62-65, column 4, lines 19-23, column 5, lines 15-29, column 7, lines 12-16, column 8, lines 21-30, column 16, lines 14-26, column 18, lines 56-67 and columns 19-20. The '744 Patent teaches wherein the antibodies are monoclonal, see in particular column 19, lines 37-45. Humanized antibodies are disclosed at column 7, lines 12-16 and pp. line 20 and column 19, lines 46-59. Antibody fragments are disclosed at columns 19-20, paragraph spanning. Labeled antibodies are disclosed for example at column 24, lines 23-50. "Specifically binding" is noted at column 8, lines 21-30. Thus, the reference teachings anticipate the claimed invention.

#### **Status of Claims**

7. No claims are allowed.

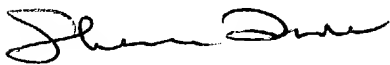
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8. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (571) 272-0894. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached at (571) 272-0887.



Sharon L. Turner, Ph.D.  
June 21, 2004